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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,619	11/29/2001	Katsumi Noritomi	1155-0233P	2288

2292 7590 07/07/2003

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 07/07/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/995,619

Applicant(s)

NORITOMI ET AL.

Examiner

D. Lawrence Tarazano

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 135).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4. 6) ☐ Other: .

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. Claim 3 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 112***

2. Claim 3 provides for the use of the release sheet in the production of imitation leather, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitsui (JP-06-160135).

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5. The Mitsui patent teaches release films which are used in the production of synthetic leather. These release sheets have a paper substrate and a layer of polymethylpentene copolymer, wherein the comonomer is a material such as decene (examples 1-3).

6. While the examples use 2.2% comonomer, the patent clearly envisages larger amounts of monomer can be used because the polymer contains at least 80% by weight methylpentene.

7. The examples use decene as a comonomer, which is a 10 carbon chain unsaturated monomer, thus meeting the applicant's (claim 2). Furthermore, a large number of the monomers recited are C<sub>10</sub> to C<sub>20</sub> monomers as claimed (0014).

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al. (JP-05-104694) with additional evidence provided by Shigemoto et al (5,080,979).

9. Hashimoto et al. teach a paper substrate having a methyl-pentene / decene copolymer bonded thereto. The methyl-pentene / decene copolymer is a Mitsui product (DX820) having a density of 0.833 g/cc, but they are silent regarding the comonomer content.

10. The crystallinity of a polymer is directly related to the density of the polymer. A homopolymer will be more crystalline than a copolymer of the same monomer. The comonomer disrupts the backbone chain so that when the polymer solidifies, it becomes less dense because the material cannot pack as well in the crystal lattice.

11. Shigemoto et al (a Mitsui Patent) teach a copolymer of methyl pentene and 5% decene results in a polymer having a density of 0.84 g/cc, which is greater than the density of the material used in Hashimoto et al., which has a density of 0.833. An increased comonomer content in Hashimoto et al. would be the reason for the lower density shown.

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12. The applicants claim a range of 6 to 8% . Given the density and comonomer content of similar materials, the examiner believes that the materials used in Hashimoto et al. are inherently within the claimed comonomer content.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui (JP-06-160135).

15. The Mitsui patent as discussed above teaches release films which are used in the production of synthetic leather. These release sheets have a paper substrate and a layer of polymethylpentene copolymer, wherein the polymer contains at least 80% by weight methylpentene, while the examples use 2.2% comonomer, the patent clearly teaches larger amounts of monomer can be used. The examples use decene as a comonomer, which is a 10 carbon chain unsaturated monomer, thus meeting the applicant's (claim 2). Furthermore, a large number of the monomers recited are C<sub>10</sub> to C<sub>20</sub> monomers as claimed (0014).

16. While there is no specific example using the claimed comonomer content, there is overlap between the claimed range and that taught in the prior art. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that choosing the overlapping portion, of the range taught in the prior art and the

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range claimed by the applicant, has been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

While the applicants have some comparative data, the claims are commensurate to the scope of the showing in the specification.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano  
Primary Examiner  
Art Unit 1773

A handwritten signature in black ink, appearing to be 'DLT' with a stylized flourish at the end.

dlt  
June 28, 2003